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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,029	09/15/2003	Jeff Karn	5887-311US	2560
570	7590	03/04/2005	EXAMINER	
AKIN GUMP STRAUSS HAUER & FELD L.L.P. ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103-7013			RADA, ALEX P	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/663,029

Applicant(s)

KARN ET AL.

Examiner

Alex P. Rada

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

In response to the amendment filed November 26, 2004 in which the applicant amends claims 10, 20, and 29 and claims 1-29 are pending in this office action.

### *Drawings*

1. The drawings were received on November 26, 2004. These drawings are acceptable.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 8-15, 18-24, and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over 123 Free Solitaire (Golf) in view of Solitaire MahJongg.
4. 123 Free Solitaire (Golf) discloses the following:
  - (a) A deck of cards having a plurality of individual playing cards, each of the individual playing cards having an associated face value (figure 1),
  - (b) A playing area within the display (figure 1),
  - (c) A shoe of cards configured to accept cards of the deck that have been selectively removed from the playing area by a player, the shoe being disposed proximate to or within the playing area (figure 1), and

(f) A set of rules dictating scoring of the electronic card game, the rules including,

(i) Selecting cards from the playing area that are not covered by other cards and that have a face value that is one face value higher or one face value lower than the face value of the last card showing in the shoe (figure 3),

(ii) Scoring points based upon a run of play, a run of play being a duration of time when the player can selectively remove cards that are one face value higher or one face value lower than the face value of the last card in the shoe (figure 3),

(iii) Permitting a card to become playable when all of the cards of have been removed (figure 3), and

(iv) Allowing, in at least some instances, three or more cards in the first layer to become playable when one card is removed (figures 1-4) as recited in claims 1, 11, and 22.

The cards have conventional face values including Ace, two, three, four, five, six, seven, eight, nine, ten, Jack, Queen, and King (figures 1-4) as recited in claims 2 and 12.

The cards further include denominations including Hearts, Diamonds, Clubs and Spades (figures 1-4) as recited in claims 3 and 13.

A total score indicator being disposed proximate to or within the playing area, the total score being incremented or decremented based upon the number of cards selected by the player in a run (figure 1) as recited in claims 4, 14, and 23.

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The total score is also a function of the amount of time the player takes to select the next playable card (figure 1) as recited in claims 5, 15 and 24.

A plurality of decks of cards forming additional layers in overlying relationship relative to the second layer of cards (figure 1-5) as recited in claims 8, 18, and 27.

123 Free Solitaire (Golf) does not expressly disclose the following:

- (c) A first layer of cards of the deck being disposed on the playing area,
- (d) A second layer of cards of the deck being disposed on the playing area in overlying relationship to the first layer of cards, at least one card of the second layer of cards partially covering cards of the first layer of cards as recited in claim 1, 11, and 22.

The cards have a polygonal shape with more than four sides to permit overlying relationship with more than four cards as recited in claims 9 and 19.

The cards have a shape selected from the group consisting one of a diamond shape, a square shape, a rectangular shape, a circular shape, a pentagonal shape, an octagonal shape, and a non-linear shape as recited in claims 10, 20, and 29.

Placing a third layer of cards of the deck on the playing area in overlying relationship to the second layer of cards so that at least one card of the third later of cards partially covers at least three cards of the second later of cards as recited in claim 21.

Solitaire MahJongg teaches the following:

Different variations of Solitaire Mahjongg having layers of tiles, in which the examiner interprets the tiles to be equivalent to the cards, overlying relationship to the other layers and having a square shape with more than four sides (see attached figures 1-3). By having overlapping layers of cards on a playing area, one of ordinary skill in the art would provide game players a different look and feel to an old game.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify 123 Free Solitaire (Golf) to include cards displayed in an overlying relationship having and a square shape with more than four sides as taught by the different variations of Solitaire MahJongg to provide game players a different look and feel to an old game.

The underlying game of applicant's invention is the same as the cited prior art. The underlying game of applicant's invention is a deck of cards, a playing area, several layers of cards disposed on the playing area, a set of rules dictating scoring of the game, selecting a card from the playing area that is one face value higher or one face value lower than the face value of the last card showing in the shoe, and scoring points based upon a run of play until there is no more possible moves to score. The underlying game of the combined cited prior art discloses a deck of cards, a playing area, several layers (tiles) of cards disposed on the playing area, a set of rules dictating scoring of the game, selecting a card from the playing area that is one face value higher or one face value lower than the face value of the last card showing in the shoe, and scoring points based upon a run of play until there is no more possible moves to score. The only difference between the

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applicant's invention and the cited prior art is the different configuration types of how the cards are laid out on a display.

5. Claims 6-7, 16-17, and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over 123 Free Solitaire (Golf) in view of Solitaire MahJongg as applied to claims 1, 11, and 22 above, and further in view of Kelly et al (US 5,882,258).

6. 123 Free Solitaire (Golf) in view of Solitaire MahJongg disclose the claimed invention as discussed above except for the following:

A wildcard being disposed proximate to or within the playing area and separate from the layers of cards and the shoe, the wildcard being selectable by the player when there are no playable cards that are one face value higher or one face value lower than the face value of the last card in the shoe as recited in claims 6, 16, and 25.

A wildcard being disposed proximate to or within the playing area and separate from the layers of cards and the shoe, the wildcard being selectable by the player at anytime thereby permitting the player to select any playable card as recited in claims 7, 17, and 26.

The cards have a polygonal shape with more than four sides to permit overlying relationship with more than four cards as recited in claims 9, 19, and 28.

Kelly et al teaches the following:

A wildcard being disposed proximate to or within the playing area and separate from the layers of cards and the shoe, the wildcard being selectable by the player when there are no playable cards that are one face value higher or one

face value lower than the face value of the last card in the shoe (column II, lines 7-40) as recited in claims 6, 16, and 25.

A wildcard being disposed proximate to or within the playing area and separate from the layers of cards and the shoe, the wildcard being selectable by the player at anytime thereby permitting the player to select any playable card (column II, lines 7-40) as recited in claims 7, 17, and 26. By having a wild card feature, one of ordinary skill in the art would provide game players to exercise skill to an enhanced degree in the game.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify 123 Free Solitaire (Golf) to include a wildcard being disposed proximate to or within the playing area and separate from the layers of cards and the shoe, the wildcard being selectable by the player when there are no playable cards that are one face value higher or one face value lower than the face value of the last card in the shoe and at anytime thereby permitting the player to select any playable card as taught by Kelly to allow a player to exercise skill to an enhanced degree in the game.

### *Response to Arguments*

7. Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection.



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*Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Solitaire Maniac website disclose a collection of different version of solitaire including an example of Kaleidoscope from the version 1.4 released 3 March 2002.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 571-272-4452. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Harrison can be reached on 571-272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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*Chanda L. Harris*  
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PRIMARY EXAMINER